UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,370	01/18/2002	Jeffrey Doubrava	50963	7001

21874 7590 02/26/2004

EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
ANDREWS, MELVYN J	
ART UNIT	**PAPER NUMBER**
1742	

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/051,370	DOUBRAVA ET AL.	
	Examiner	Art Unit	
	Melvyn J. Andrews	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *20* is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *092102*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 to 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weakly et al (US 6,267,871) in view of DeBoer et al (US 5,302,183). and Courduvelis

(US Patent No.4,600,699). Weakly et al discloses a process for removing metals from aqueous solutions from the plating industry (col. 1, line 11) that contain **colloidal forms of the metal** comprising flowing the aqueous solution between two electrodes and flowing through a **filter** that is not in a high voltage field (col.18, lines 53 to 65) and further explains at (col.12, lines 26 to 32) that:

> The metal, however, does not plate, but instead, is deposited as native metal, such as native gold, as a metalliferous sludge-like material. Once sufficient time has passed for the filters to become saturated with metal, the filters are back flushed and the sludge collected or the filters are replaced. The filters may be stripped using standard technology or sent to a refiner for further processing.

the filters may be of granulated carbon, activated carbon and resins ...or any other filter type designed to catch a particular **metal colloid** or ion.(Col.15, lines 36 to 42) but does not explicitly disclose the how the filters may be stripped by standard technology or sent to a refiner for further processing and does not explicitly disclose recovery of palladium-tin catalyst but these techniques are well known as evidenced by DeBoer et al which discloses the recovery of a precious metal from a non-aqueous effluent comprising contacting the effluent with a reduction agent, depositing the precious metal onto a carrier, such as carbonaceous combustible material, and separating the precious metal loaded carrier from the effluent and further comprises combusting the carbonaceous combustible carrier loaded with precious metal and reclaiming the precious metal from the combustion residue (col.8, lines 26 to 30) it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the DeBoer et al process including combustion to the Weakly et al product which may be activated carbon loaded with precious metal in order to recover the precious metal .

Claims 8, 10, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weakly et al (US 6,267,871) in view of DeBoer et al (US 5,302,183) as applied to claim1 above, and further in view of Courduvelis (US Patent No.4,600,699). Weakly et al and DeBoer et al do not explicitly disclose the recovery of a palladium-tin alloy but Courduvelis discloses a method for the recovery of palladium-tin catalyst from an exhausted catalytic solution to recover palladium metal (col.1, line 64 to col.2, line 20) and (col.2, line 55 to col.3, line 2) it would be obvious to one of ordinary skill in the art to recover palladium and tin such as disclosed by Courduvelis by the Weakly et al and DeBoer et al the motivation being to recover palladium metal from a plating solution in which solids are filtered from the plating solution prior to being further treated by stripping and/or burning.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 16 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to

20 of copending Application No. 10/301,075. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '370 method comprising steps of a) concentrating... , b) removing... c) collecting... and burning are suggested by the '075 method steps of a) concentrating..., b) incinerating... and c) retrieving...

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/301,367. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '370 process comprising a) concentrating..., b) removing and collecting is suggested by the '367 method comprising a) concentrating..., b) removing..., c) solubilizing ...and d) retrieving... .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 8 and 13 recites the limitation "the non-catalytic metal" There is insufficient antecedent basis for this limitation in the claims.

Allowable Subject Matter

Claim 20 is allowed.

The following is an examiner's statement of reasons for allowance: the patents to Weakly et al (US 6,267,871) , DeBoer et al (US 5,302,183) and Courduvelis (US 4,600,699) do not disclose or suggest the claimed method of recovering palladium metal from a tin/palladium catalytic colloid by the sequence of steps of Claim 20.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvyn J. Andrews whose telephone number is (571)272-1239. The examiner can normally be reached on 8:00A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mja
February 13, 2004